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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,773	09/30/2003	Victor C. Li	UOM 0286 PUS	4443
22045	7590	05/27/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,773

Applicant(s)

LI ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's arguments filed 3/11/05 have been fully considered but they are not persuasive.

Obviousness-Type Double Patenting:

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 1-14 of Li et al. of copending Application No. 09/902,064 (US 2002/0019465 A1) and 10/674,772 (US 2005/0066857). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a cement composition with the same components as applicants in overlapping amounts and overlapping amounts would have been prima facie obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 24-26 of U.S. Patent No. 6,809,131 B2 (Li et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a cement composition with the same components as applicants in overlapping amounts and overlapping amounts would have been prima facie obvious to one of ordinary skill in the art.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 102/103:

*Note: Several references that were withdrawn were removed from the rejection because they do not teach reinforcing fibers. Applicants limitation of from 0.1 to 4 volume percent reinforcing fibers in claim 1 resulted in the withdrawal of these references. Also, Drs et al. and Tjugum et al. have been also withdrawn because both teach steel and/or steel and polypropylene fibers which **does not produce strain hardening behavior** as is required by b) of claim 1 (see also p.10 of applicants' specification, last paragraph).*

The applicants' amendment of claims (e.g. claim 1) necessitated the new grounds of rejection below:

Claims 1-13 are rejected under 35 U.S.C. 103(a) as obvious over Baeuml et al. '607 B2, Kodama et al. (JP 2001220188-abstract only), or Kanda et al. (JP 2002193653-abstract only).

Baeuml et al. teach a composition comprising Portland cement (non-Newtonian additive), polyethylene fibers or polyvinyl alcohol fibers (col.3, lines 1-40), and plasticizers (col.5, line 18). Baeuml et al. teach the same components in overlapping

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amounts and overlapping amounts would have been prima facie obvious to one of ordinary skill in the art.

Kodama et al. (JP 2001220188) teaches a coating material comprising cement, silica sand, superplasticiser, and water. Kodama et al. teach the same components in overlapping amounts and overlapping amounts would have been prima facie obvious to one of ordinary skill in the art.

Kanda et al. (JP 2002193653) teach a cement that is sprayable comprising polyvinyl alcohol short fibers, water, and superplasticizer. Kanda et al. teach the same components in overlapping amounts and overlapping amounts would have been prima facie obvious to one of ordinary skill in the art.

35 USC 112 Second Paragraph:

Claims 1-13 remain rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 1 remains indefinite because the cement fraction can also be the inorganic Non-Newtonian additive (components a) and c)). The non-Newtonian additive can be calcium aluminate and claim 1 a) only requires cement fraction which also can be calcium aluminate. How do applicants distinguish between component a and c?

The term "associative thickener" remains vague in claim 5. The applicants state that this term is well known in the art. However, it is respectfully requested that applicants provide support for this assertion that this is a term well known in the art. A

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definition or use in a technical paper would suffice. Should they do so, this rejection will be withdrawn.

The term "high" with respect to density polyethylene polymers in claim 8 is a relative and indefinite term as applicants do not define a specific range of density they deem high. The term "density" was not at issue but the word "high" so the change to modulus was not necessary. Applicants have not yet defined what they mean by high density (now high modulus).

Claim 13 remains indefinite because it would not appear to teach the **total** parts by weight of the mortar composition.

Response:

The applicants' corrected some of the issues under 35 USC 112 second paragraph but would not appear to have overcome all of them. They are listed above. Also, the examiner has withdrawn all previous prior art as a result of applicants amendment to their claims, claim 1 in particular. This necessitated the new grounds of rejection above.

The finality of this office action is now proper. The applicants amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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